Remarks

Claims 1-68 were pending in the application. By this amendment, claims 14, 16 and 54-56 have been amended, claims 69-76 have been added, and claims 18-40 and 58-68 have been canceled without prejudice or disclaimer. Thus, claims 1-17, 41-57 and 69-76 remain pending for consideration. For the reasons set forth below, Applicant submits that each of the pending claims is patentably distinct from the cited prior art and in condition for allowance. Reconsideration of the claims is therefore respectfully requested.

Claim Objections

The Office Action objected to claims 14, 16, 54 and 56 for minor informalities. In response, Applicants have amended claims 14, 16, 54 and 56 according to the Examiner's suggestions. In addition, to maintain consistency between claims, Applicants have amended claims 55 and 56 to depend from claim 54. Accordingly, Applicants respectfully request withdrawal of the objection to the claims.

Claim Rejections - 35 U.S.C. § 102

Claims 1-8, 12, 13, 41-48, 52 and 53 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Publication No. 2002/0174444 by Gatto et el. ("Gatto"). Applicants respectfully traverse this rejection because Gatto fails to identically teach every element of the claims. See M.P.E.P. § 2131 (stating that in order to anticipate a claim, a prior art reference must <u>identically</u> teach every element of the claim).

1. <u>Gatto does not teach or suggest evaluating a user intention to enter into a transaction to select specific instances of user-specific information that are relevant to the transaction.</u>

Gatto teaches that e-commerce servers are not optimized to provide an instantaneous acknowledgement of a purchase request. Page 1, paragraph [0010], lines 10-12. Thus, when an immediate transaction is not possible, the context of the transaction is stored in non-volatile cache memory so as to "enable a recovery of the transaction after an interruption thereof." Page 2, paragraph [0014], lines 10-13.

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Page 4 of the Office Action cites paragraphs [0019], [0104], and [0106] of Gatto to show that Gatto teaches user-supplied information "such as user ID, address, payment information, and delivery information." However, Applicants respectfully submit that the use of such information, by itself, does not teach or suggest the subject matter of independent claims 1, 41 and 69.

In particular, claim 1 recites, among other things, "*evaluating* the first indication of user intention to enter into a first transaction *to select a first plurality of specific instances* of information from said first plurality of user-specific information *based upon relevance* to the first transaction." (Emphasis added). Claim 41 includes similar limitations. Further, claim 69 recites, among other things, "means for *selecting a subset of said plurality of user-specific information based on relevance to a user transaction* through the interactive television." (Emphasis added).

Applicants respectfully submit that Gatto is silent as to evaluating a transaction to select specific instances of user information based on relevance to the transaction. Further, paragraphs [0104] and [0106] of Gatto specifically teach that the set top box (STB) shown in FIGS. 11 and 12 "according to the present invention may encapsulate *all* the user-supplied aforementioned information in a single data packet" that may be stored in cache memory and routed through a network to a remote server. Thus, Gatto teaches using all of the user-supplied information without selecting a portion of it based on relevance to a transaction.

2. Gatto does not teach or suggest storing user-specific information received at a remotable device for interactive television in a smart card.

An aspect of independent claims 1, 41 and 69 is the ability to store information that has been received at a remotable device for interactive television in a user-modifiable smart card. For example, FIGS. 2A, 2B and 3 of the present application, which illustrate both a smart card reader 220 and a *smart card writer* 315.

Page 4 of the Office Action cites FIG. 8 and paragraphs [0104], [0106] and [0113] of Gatto for the assertion that Gatto teaches storing user-specific information, that has been received at a remotable device for interactive television, in a smart card. Applicants respectfully disagree. FIG. 8 of Gatto merely shows a smart card reader 506 and provides no indication of a smart card writer.

Further, paragraphs [0104], [0106] and [0113] of Gatto are silent as to storing information received at a remotable device for interactive television in a smart card. Paragraphs [0104] and [0106] state that a user may provide information that "may be *inputted* by the user or *retrieved* automatically from secured personal storage[,] such as from the Personal Remote Control 502." (Emphasis added). However, there is no indication that the inputted information is then stored in a smart card. Further, information can only be retrieved from the Personal Remote Control 502. See also FIG. 5 (illustrating that the Personal Remote Control 502 only interfaces with smart card readers 506).

In addition, paragraph [0113] of Gatto, which is recited in its entirety below, is completely silent as to the subject matter of claims 1, 41 and 69.

> [0113] In the example illustrated in FIG. 13, the third retry packet (9) reaches its destination (the remote server 534) and the transaction is successfully executed (10). A confirmed acknowledgment is routed back through the network (11). A copy of the returned acknowledgment packet is copied to the trusted cache 918 (12), and a confirmed acknowledgment may be retained in the trusted cache 918 (13) and optionally provided to the user upon request.

In particular, Gatto does not teach or suggest "*receiving* a first plurality of user-specific information at a remotable device for interactive television; *storing* said first plurality of user-specific information *in a smart card*," as recited, among other things in claim 1. Also, Gatto does not teach or suggest "code that *receives* a first plurality of user-specific information at a remotable device for interactive television; code that *stores* said first plurality of user-specific information *in a smart card*," as recited, among other things, in claim 41. Further, Gatto does not teach or suggest "means for receiving a plurality of user-specific information at an interactive television; means for *storing* said plurality of user-specific information *in a user-modifiable smart card*," as recited, among other things, in new claim 69.

Thus, for at least the foregoing reasons, Applicants respectfully request that the rejection of claims 1 and 41 be withdrawn and that new claim 69 be allowed.

<u>Claim Rejections - 35 U.S.C. § 103</u>

Claims 8-11, 14-16, 48-51 and 54-56 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Gatto in view of U.S. Patent No. 6,424,947 issued to Tsuria et al. ("Tsuria"). This rejection is respectfully traversed. As set forth below, Applicant respectfully submits that each of the pending claims is patentably distinct from the cited references, individually and collectively.

In order to establish a *prima facie* case of obviousness for a claim, the prior art references must teach or suggest a̲l̲l̲ the claim limitations. See M.P.E.P. § 2143. As discussed above, Gatto fails to teach or suggest evaluating a user intention to enter into a transaction to select specific instances of user-specific information that are relevant to the transaction. Gatto also fails to teach or suggest storing user-specific information received at a remotable device for interactive television in a smart card.

Applicants also respectfully submit that Tsuria is silent as to the subject matter of independent claims 1, 41 and 69. For example, Tsuria, either individually or when combined with Gatto, does not teach or suggest *evaluating* a user intention to enter into a transaction *to select specific instances of user-specific information* that are relevant to the transaction.

Further, according to pages 7 and 8 of the Office Action, "Tsuria discloses an interactive television transaction system...wherein a smart card inserted into the remote control...will store content accessibility information." However, Applicants respectfully assert that having content accessibility information stored on a smart card does not by itself teach storing user-specific information received at a remotable device for interactive television in a smart card, as discussed above. The limits referenced on Page 8 of the Office Action are *"programmed" into the processor 24* of the IRD 12 using the remote control 14. See Tsuria, col. 11, line 64 to col. 12, line 2. Further, FIG. 1 illustrates two smart card readers 32, 58 and does not show a smart card *writer*.

Accordingly, Applicants respectfully submit that Gatto and Tsuria, either individually or when combined, fail to teach or suggest each and every element of independent claims 1, 41 and 69.

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New Claims 69-76

Applicants submit that new claims 69-76 are each patentable for the reasons discussed above and do not add new matter to the application. Therefore, Applicants respectfully request that claims 69-76 be allowed.

Conclusion

For at least the foregoing reasons, the cited prior art references, whether considered individually or in combination, fail to disclose each of the limitations in any of the pending independent claims. For at least the same reasons, each of the claims depending therefrom are also patentably distinct from the cited prior art.

In view of the foregoing, all pending claims represent patentable subject matter. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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